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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/030,098      | 05/03/2002  | Shogo Ishioka        | 011713              | 5721             |

38834 7590 02/15/2005

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP  
1250 CONNECTICUT AVENUE, NW  
SUITE 700  
WASHINGTON, DC 20036

EXAMINER

ROSEN, NICHOLAS D

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3625

DATE MAILED: 02/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/030,098

Applicant(s)

ISHIOKA ET AL.

Examiner

Nicholas D. Rosen

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 9/20/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 03 May 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>10/1/2002</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

Claims 1-11 have been examined.

#### ***Priority***

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on May 17, 2000 (Application 2000-145297). It is noted, however, that applicant has not filed a certified copy of the Japanese application as required by 35 U.S.C. 119(b), or at least no such copy has been found in the file, although there is a copy of the PCT Application PCT/JP01/04099.

#### ***Specification***

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because the abstract is longer than 150 words (it is 167 words, or perhaps slightly shorter depending on how one counts compound words). Correction is required. See MPEP § 608.01(b).

Examiner suggests that removing the reference numbers would be an easy step toward shortening the abstract.

### ***Claim Objections***

Claims 1-3 are objected to because of the following informalities: In the ninth line of claim 1, there should be a comma after "said product". Appropriate correction is required.

Claims 4-6 objected to because of the following informalities: In the eighth line of claim 4, there should be a comma after "said product", and at the end of the fourth and tenth lines, the commas after "including" should preferably be colons. Appropriate correction is required.

Claims 5 and 6 are objected to because of the following informalities: In the fourth line of claim 5, the antecedent of the word "them" is not entirely clear (presumably, "said products dealt by said store"). Also, there should be a period at the end of claim 5. Appropriate correction is required.

Claims 7 and 8 are objected to because of the following informalities: In the fourth line of claim 7, "said user" lacks antecedent basis; in the sixth and seventh lines of claim 7, and again in the eighth line of claim 7, "said server system" should be "said server apparatus" to be compatible with the preamble. Appropriate correction is required.

Claim 8 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is

required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 8 recites a computer readable medium, which does not further limit the server apparatus of claim 7. The test is whether it would be possible to infringe the dependent claim without infringing the independent claim (MPEP 608.01(n)), and claim 8 fails this test, because one could manufacture and possess a computer readable medium according to claim 8 without making or possessing the server apparatus of claim 7.

Claim 10 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 10 recites a computer readable medium, which does not further limit the information-processing terminal of claim 9. The test is whether it would be possible to infringe the dependent claim without infringing the independent claim (MPEP 608.01(n)), and claim 10 fails this test, because one could manufacture and possess a computer readable medium according to claim 10 without making or possessing the information-processing terminal of claim 9.

Claim 8 is objected to because of the following informalities: Claim 8 recites "A computer readable media". "Media" is properly the plural of medium, so claim 8 should recite, "A computer readable medium". Appropriate correction is required.

Claim 10 is objected to because of the following informalities: Claim 10 recites "A computer readable media". "Media" is properly the plural of medium, so claim 10 should recite, "A computer readable medium". Appropriate correction is required.

Claim 11 is objected to because of the following informalities: In the seventh line of claim 10, "said the product" should be either "said product" or "the product". Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 11 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim is directed to a method not within the technological arts ("technological arts" being considered equivalent to "useful arts," mentioned in Article I, Section 8 of the United States Constitution, saying that Congress shall have "power to promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writing and Discoveries" – see *In re Musgrave*, 431 F.2d 882, 167 USPQ [CCPA 1970]). The claims are directed to a method that does nothing more than manipulate an abstract idea. To be patentable, a method claim must produce a useful, concrete, and tangible result, or involve a step or act of manipulating technology (see *AT&T v. Excel Communications Inc.*, 172 F.3d at 1358, 50 USPQ 2d. at 1452). An information service method may be, in a sense, useful, but is not concrete or tangible. (Storing information

would be, in itself, only a trivial application of technology even if use of an electronic database were recited; and, as the claim stands, the information could be stored in someone's head.)

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

#### **Claims 1 and 2**

Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by Hulls et al. (U.S. Patent Application Publication 2001/0032229). As per claim 1, Hulls discloses an information service method for providing information via a network including a first information-processing apparatus and a second information-processing apparatus (Figure 1), said information service method comprising steps of: inputting identification information of a product for purchase from a user of said network to said first information-processing apparatus (Figures 3 and 4; paragraphs 29 and 30); inputting an order for a surrogate investigation of said product from said user to said first information-processing apparatus (Figure 5, especially fields 26, 27, and 28; paragraph 31); and transmitting identification information of said user, identification information of said product, and an instruction on said surrogate instruction from said first information-

processing apparatus to said second information-processing apparatus (Figures 8, 10, and 13; paragraphs 32, 33, and 39-43); Hulls is not fully explicit about storing said user identification information and said product identification information in said second information-processing apparatus, but does disclose storing information at a central site (paragraph 25), and from Hulls's disclosure of making information available to an agent, the information would inherently have to be stored on the second information-processing apparatus, whether one reads "second information-processing apparatus" as referring to the Site Computer System in Figure 1 of Hulls, in which case the information would have to be stored to be made available to agents as they log on (paragraph 25, and paragraphs 38-42), or as referring to the Agent's Computer/Modem in Figure 1 of Hulls, in which case the information would have to be stored, at least temporarily, at the agent's computer to be displayed. Hulls discloses calling said product identification information from said second information-processing apparatus to identify said product so as to conduct an investigation of said identified product by an appointed investigation agent (paragraphs 38-42; Figures 9, 10, and 13); and providing information obtained from said investigation to said user identified on the basis of said user identification information (paragraphs 43, 44, and 45; Figures 16, 16B, 17, 20, and 21).

As per claim 2, Hulls discloses publishing information for designating a store and information about products dealt by said store on said network including said first and second information-processing apparatuses (paragraphs 34-36; Figures 1, 23, 24, 25),



wherein said user (the buyer) identifies a product for purchase among said published products (paragraphs 45 and 46; Figures 5, and 6).

#### **Claims 4 and 5**

Claims 4 and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by Hulls et al. (U.S. Patent Application Publication 2001/0032229). As per claim 4, Hulls discloses an information service system for providing information via a network, said information-processing service system comprising: a first information-processing apparatus and a second information-processing apparatus (Figure 1), said first information-processing system including: means for acquiring identification information of a product purchase and an order of a surrogate investigation of said product (Figures 3, 4, and 5, especially fields 26, 27, and 28 of Figure 5; paragraphs 29, 30, and 31), and means for transmitting identification information of said user, identification of said product, and an instruction of said surrogate investigation, to said second information-processing apparatus (Figure 1; paragraphs 23-25); and said second information-processing apparatus including: means for storing said user identification information and said product identification information with a certain association therebetween (paragraphs 25 and 38-45), and means for providing information about a result of an investigation by an appointed investigation agent to said user, said investigation being related to said product identified on the basis of said information stored in said storing means (Figure 1, paragraphs 23-26, and 38-48).

As per claim 5, Hulls discloses acquiring means operable to acquire the identification information of a product for purchase and the order in parallel with

publishing information for designating a store and information about products dealt by said store on said network to provide the products to the buyer/user (paragraphs 34-36; Figures 1, 23, 24, 25).

**Claim 7**

Claim 7 is rejected under 35 U.S.C. 102(e) as being anticipated by Hulls et al. (U.S. Patent Application Publication 2001/0032229). Hulls discloses a server apparatus (the Site Computer System shown in Figure 1) to be connected to an information-processing terminal (the Buyer's Computer/Modem) via a network, said information-processing terminal including: means for acquiring identification information of a product for purchase and an order of a surrogate investigation of said product from a user of said network (Figures 1, 3, 4, and 5, especially fields 26, 27, and 28 of Figure 5; paragraphs 29, 30, and 31), and means for transmitting identification information of said user, identification of said product, and an instruction of said surrogate investigation, to said server system (Figure 1; paragraphs 23-25); and wherein said server system comprises: means for storing said user identification information and said product identification information with a certain association therebetween (paragraphs 25 and 38-45), and means for providing information about a result of an investigation by an appointed investigation agent to said user, said investigation being related to said product identified on the basis of said information stored in said storing means (Figure 1, paragraphs 23-26, and 38-48).

**Claim 9**

Claim 9 is rejected under 35 U.S.C. 102(e) as being anticipated by Hulls et al. (U.S. Patent Application Publication 2001/0032229). Hulls discloses an information-processing terminal (the Buyer's Computer/Modem shown in Figure 1) to be connected to a server apparatus (the Site Computer System shown in Figure 1) via a network, said server apparatus including: means for storing identification information of a user of said network and identification information of a product for purchase with a certain association therebetween (paragraphs 25 and 38-45), and means for providing information about a result of an investigation by an appointed investigation agent to said user, said investigation being related to said product identified on the basis of said information stored in said storing means (Figure 1, paragraphs 23-26, and 38-48); and wherein said information-processing terminal comprises: means for acquiring identification information of a product for purchase and an order of a surrogate investigation of said product from said user of said network (Figures 1, 3, 4, and 5, especially fields 26, 27, and 28 of Figure 5; paragraphs 29, 30, and 31), and means for transmitting identification information of said user, identification of said product, and an instruction on said surrogate investigation, to said server apparatus (Figure 1; paragraphs 23-25).

**Claim 11**

Claim 11 is rejected under 35 U.S.C. 102(e) as being anticipated by Hulls et al. (U.S. Patent Application Publication 2001/0032229). Hulls discloses an information service method comprising the steps of: acquiring identification information of an

applicant for purchase and of a product for purchase designated by said applicant (Figures 3 and 4; paragraphs 29 and 30); storing said acquired identification information (paragraph 25; see also Hulls's description of making the information available to an agent; Figures 8, 10, and 13; paragraphs 32, 33, and 39-43); acquiring an order for a surrogate investigation of said product from said applicant (Figure 5, especially fields 26, 27, and 28; paragraph 31); and providing information obtained from an investigation of said product by an appointed investigation agent, to said applicant on a basis of the stored identification information (paragraphs 43, 44, and 45; Figures 16, 16B, 17, 20, and 21).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claim 3**

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hulls et al. (U.S. Patent Application Publication 2001/0032229) as applied to claim 1 or 2 above, and further in view of official notice. Hulls does not disclose designating the level of an investigation or a deadline for the answer of said investigation, but official notice is taken that it is well known to designate a deadline for finding or purchasing a desired product. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to designate the level of an investigation or a deadline for the answer of said investigation, for the obvious advantage of attempting to obtain a product or information about a product before the product is needed, e.g., for a particular project, or as a birthday present, etc.

**Claim 6**

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hulls et al. (U.S. Patent Application Publication 2001/0032229) as applied to claim 4 or 5 above, and further in view of official notice. Hulls does not disclose that the acquiring means is operable to acquire designated information about the level of an investigation or a deadline for the answer of said investigation, but official notice is taken that it is well known to designate a deadline for finding or purchasing a desired product. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to acquire designated information about the level of an

investigation or a deadline for the answer of said investigation, for the obvious advantage of attempting to obtain a product or information about a product before the product is needed, e.g., for a particular project, or as a birthday present, etc.

**Claim 8**

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hulls et al. (U.S. Patent Application Publication 2001/0032229) as applied to claim 7 above, and further in view of official notice. Hulls does not expressly disclose a computer readable medium storing a program to be read in and executed on a computer to implement the server apparatus as defined in claim 7. However, official notice is taken that computer readable media storing programs to cause computers to carry out their intended functions are well known. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to use such a computer readable medium storing a program, for the obvious advantage of causing the server apparatus to carry out its disclosed functions.

**Claim 10**

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hulls et al. (U.S. Patent Application Publication 2001/0032229) as applied to claim 9 above, and further in view of official notice. Hulls does not expressly disclose a computer readable medium storing a program to be read in and executed on a computer to implement the information-processing terminal as defined in claim 9. However, official notice is taken that computer readable media storing programs to cause computers to carry out their

intended functions are well known. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to use such a computer readable medium storing a program, for the obvious advantage of causing the information-processing terminal to carry out its disclosed functions.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Perkowski (U.S. Patent 6,064,979) discloses a method of finding and serving consumer product information over the Internet. Walker et al. (U.S. Patent 6,108,639) disclose a conditional purchase offer management system for collectibles, with inspection/investigation of collectibles. Haseltine (U.S. Patent Application Publication 2001/0037247) disclose a method and system providing outsourced merchandise return services and exchange and escrow services. Brody et al. (U.S. Patent Application Publication 2002/0013761) disclose an auction system and method.

Kikukawa (Japanese Published Patent Application 11-25020-A) discloses an inspection agency service for informing a requester of a change in contents of a www-carried program. (This appears to have been submitted by the Applicant, but not listed on the IDS.)

Gair ("Site Watch for Home Workers") discloses employing professional shoppers to find items selling at low prices. The anonymous article, "Pokemon Yellow Bundle Continues to Elude Holiday Shoppers," discloses a reporting network with information from investigations on the availability, etc., of desired products. Donaldson

("Is This Site for Real?") discloses verifying site content, including a random brick-and-mortar company inspection. Brody et al. ("Pocket BargainFinder: A Handheld Device for Augmented Commerce") disclose finding an item of interest in a physical store, and searching for a lower price among online retailers. McCullen ("E-Browsers Frustrate Retailers") discloses coming into physical stores to investigate products for possible purchase online. The anonymous article, "sigma-aldrich.com 'Preferred Solution' Status Confirmed by 2<sup>nd</sup> Independent Survey," discloses evaluating a plurality of chemical suppliers.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen, whose telephone number is 703-305-0753. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins, can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Non-official/draft communications can be faxed to the examiner at 703-746-5574.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Nicholas D. Rosen*  
**NICHOLAS D. ROSEN**  
**PRIMARY EXAMINER**

February 12, 2005